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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,806	12/28/2001	David P. Greene	YOR920010587US1	8447

48175 7590 08/15/2005

BMT/IBM
FIVE ELM STREET
NEW CANAAN, CT 06840

EXAMINER

CHEN, ALAN S

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,806

Applicant(s)

GREENE ET AL.

Examiner

Alan S. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/28/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/14/2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 51-54 applied to prior art references to Jovanov and Suzuki have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 51-54 are rejected under 35 USC 103(a) as being unpatentable over Garberoglio in view of Levine et al. (Levine).

7. Garberoglio discloses a method and apparatus comprising multiple devices that is in contact with the patient's body (Fig. 1, element 1 and isometric views in Figs. 2 and 3, by definition is in contact or is worn by a patient's body being resident in the body functioning as a pacemaker and drug dispenser function, Column 4, line 43-Column 5, line 50), having a device to administer a proposed treatment to the patient (Fig. 1, element 7, drug delivery device) another device with a patient identifier that identifies a patient condition, e.g., in risk of an heart ailment (Fig. 1, element 2, Column 5, lines 18-30, patient identifier equivalent to the current patient situation requiring attention obtained from sensors CT) and a third device to translate the second device (processors) signals into actions to remedy the ailment (Fig. 1, element 4; Column 5, lines 30-40), e.g., drug delivery or electrical stimulus (elements 6 and 7). Garberoglio also discloses the ability to analyze the conditions of the patient based on diagnostics performed by processor (Column 6, lines 25-30).

Garberoglio does not disclose expressly the patient identifier having a check/confirmation mechanism such that a device uses the patient identifier to confirm treatment prior to applying the treatment.

Levine discloses an implantable pacemaker (Fig. 1) having the ability to confirm and check a patient identifier with another device (Fig. 1, element 46 links up with a programmer device, element 32, sending a patient ID from pacemaker device, element 38; Column 7, line 62-Column 8, line 25 disclose specifics of patient ID; Fig. 3, element 306 shows patient identifier is read and checked with safety information on another device, element 308, and only after the check/confirmation is the action taken, element 312).

Garberoglio and Levine are analogous art because they are from the same field of endeavor involving implantable devices where patient information is read from a pacemaker and used to determine an appropriate action. Both Garberoglio and Levine disclose the patient information being transmitted through the body via an electrical signal (Column 4, lines 50-65 of Garberoglio disclose patient information being the electrical signals of the heart that result in the lead up to the diagnosis and treatment plan for the patient determined by the processor 2; Column 5, lines 19-27 in Levine).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the patient information to confirm a treatment before it is actually implemented, e.g., in Garberoglio, the patient information is used to confirm treatment before using the drug delivery device 7.

The suggestion/motivation for doing so would have been that in analyzing the patient situation in determining the proper action (Column 6, lines 25-30 of Garberoglio), e.g., drug or

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electrical stimulation, to implement, it is obvious the need to assess any complications the patient would have if the drug or electrical stimulation is implemented (Column 7, lines 62-67 of Levine). It is furthermore particularly important since patient conditions and complications can change and thus, the patient identification information in the pacemaker by Garberoglio may not be updated, hence the need to for confirmation (as shown by Levine, Column 7, lines 9-35) is critical for a smooth diagnosis and treatment procedure.

Therefore, it would have been obvious to combine Garberoglio with Levine for the benefit of checking and confirmation of a patient's health information since originally programmed information in a pacemaker may not be updated.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KIM HUYNH
PRIMARY EXAMINER

8/11/05